

REMARKS

Claims 1-9 are pending in the above-identified application. Support for the change to claim 1 and new claim 9 is found in the examples of the present specification, as well as at page 12, lines 7-13. Support for new claims 5-8 is found in original claims 3 and 4 of the present application.

Allowable Claims

Claims 3 and 4 were indicated as being allowable and were merely objected to as depending upon a rejected base claim. Claim 3 has been amended so as to be in independent form. It is also noted that no rejections were made against claim 2, such that claim 2 is also in allowable form. Thus, claims 5-8 have also been placed into allowable form since all of these claims depend from either allowable 2 or allowable claim 3. The reasons in support of the allowablity of amended claim 1, claim 4 (which depends from claim 1) and claim 9 are provided below.

Issues Under 35 U.S.C. 102(a), 102(b) and 103(a)

Claim 1 has been rejected under 35 U.S.C. 102(a) as being anticipated by JP '553 (Japanese Patent Application No. 2003-055553).

Claim 1 has been rejected under 35 U.S.C. 102(b) as anticipated by, or, in the alternative, under 35 U.S.C. 103(a) as obvious over Cleyer '587 (USP 6,017,587).

Both of the above-noted rejections are traversed for the following reasons.

Distinctions between Present Invention and the JP '553 and Kleyer '587 Documents

JP '553 discloses a semiconductive roll which includes, among other silicone-containing components, component (D) which is a "conductive material". JP '553 discloses that the described silicone rubber composition exhibits stable electrical resistance properties. In this regard, it is noted that the conductive material (D) is clearly an essential component, since otherwise the described semiconductive roll would not exhibit any significant electrical characteristics at all.

Kleyer '587 discloses an electrically conductive silicone composition which includes as component (D) at least one conductive metal particulate. It is clear from a review of the summary of the invention section as well as the context of the disclosure of Kleyer '587 that the conductive metal particles of component (D) are required to be present and are required for the composition to exhibit its electrical characteristics. Note also at column 7, lines 25-34 that component (D) is required to be present in an

amount of at least 200 parts by weight per 100 parts by weight of components (A) and (B) combined.

Both JP '553 and Kleyer '587 fail to disclose or suggest a silicone coating composition which does not include as an essential component materially affecting the properties thereof a conductive material, such as conductive metal particles. The employment of the claim language "consisting essentially of" in product claim 1, product claim 4 and method claim 9 necessarily excludes the presence of any component or method step which materially affects the properties of the claimed composition, including the presence of conductive materials such as conductive metal particles which materially affect the electrical properties of the composition. Therefore, claims 1, 4 and 9 patentably define over both JP '553 and Kleyer '587 such that the bases for these rejections has been removed. Thus, it is requested that these rejections be withdrawn.

Conclusion

It is submitted for the reasons stated above that the present claims define patentable subject matter such that this application should now be placed condition for allowance.

If any questions arise regarding the above matters, please contact Applicant's representative, Andrew D. Meikle (Reg. No. 32,868), in the Washington Metropolitan Area at the phone number listed below.


Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant(s) respectfully petition(s) for a one (1) month extension of time for filing a reply in connection with the present application, and the required fee of \$120.00 is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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By



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